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EXAMINER

CHO, HONG SOL

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL KALPATHY and MIKE JORDA

Appeal 2008-0013
Application 09/985,763
Technology Center 2600

Decided: January 14, 2009

Before MAHSHID D. SAADAT, ROBERT E. NAPPI,
and MARC S. HOFF, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request reconsideration of our Decision of June 26, 2008, wherein we sustained the Examiner's rejection of the appealed claims under 35 U.S.C. § § 102 and 103.

We have carefully considered the arguments presented by Appellants in the Request and reviewed our decision. However, those arguments do not persuade us that our decision was in error in any respect or we have

overlooked any relevant points in reaching our decision that the Examiner properly rejected claims 1, 2, 4, 6-8, 10, 12, 13, 15-17, 19, and 21 under 35 U.S.C. § 102 and claims 3, 5, 9, 11, 14, 18, 20, and 22-25 under 35 U.S.C. § 103.

1. Claim 1

Appellants argue that our analysis of the device shown in Figure 3 of Michels that memory 58 is part of switching device 50 is incorrect (Request 3-4). Appellants assert that the switching device 50 of Michels is not the same as the table search device recited in the preamble of claim 1, since search engine 60 of Michels, which appears to be the table search device, does not include a memory (Request 4). Additionally, it is Appellants' belief that since the recitation of "a table search device" in the preamble of claim 1 does "breathe life and vitality into the claim," the claim cannot read on the switching device of Michels (*id.*).

We disagree. Initially, we note that, as stated in our decision, memory 58 and search engine 60 are parts of port 52 which itself is part of switching device 50 (Michels, col. 4, ll. 40-42). Therefore, switching device 50 comprises memory 58 and search engine 60. We also stated that search engine 60 also includes memory 70 as the cache having a subset of entries (Decision 7).

Second, we find Appellants' contention that the claimed "table search device" is not the same as a switching device to be inconsistent with Appellants' disclosure. Where a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage. *Bell Communications Research, Inc. v. Vitalink*

Communications Corp., 55 F.3d 615, 620 (Fed. Cir. 1995). Conversely, where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. *Id.* In the case before us, Appellants describe their invention as related to a “new switching architecture” (Spec. ¶ [0003]) and show a network switch in Figure 6 (Spec. ¶ [0053]). Additionally, there are no recited features in the body of claim 1 that indicates the claimed “table search device” is different from a switching device such as the switching device of Michels.

We also disagree with Appellants (Request 4) that since the search engine of Michels is the table search device, which includes no memory, there is no correspondence between Michels and what is claimed. In fact, the switching device of Michels is what the Examiner characterized as the claimed table search device. Such device comprises a table in memory 58, a cache in memory 70 and a search engine 60 (Michels; Fig. 3; col. 5. ll. 33-40). Therefore, as stated in our decision (Decision 7), the search engine 60 as a part of switching device 50 does not need to include memory 58, but merely be connected to it.

2. *Claim 3*

Appellants argue that our decision discussed motivation for modifying Michels to arrive at the invention recited in claim 3 that was incorrect and different from what the Examiner had purported (Request 5). Appellants assert that based on the alleged deviation from the Examiner’s stated position our discussion of the rejection should be designated as a new ground of rejection. We disagree.

Our discussion related to the rejection of claim 3 was consistent with the position stated by the Examiner (Ans. 5) relying on column 6, lines 22-26 of Michels which stated that the partitioning of iterations across search engines could be unequal while the lookup table could have any length. The Examiner specifically stated (*id.*) that the skilled artisan would have modified the number of iterations such that the first number of cycles to search the cache (memory 70, containing 256 entries (col. 6, ll. 5-7)) may be less than the second number of search cycles (memory 58, containing 64,000 entries (col. 6, ll. 1-2)). Our decision further justified (Decision 8) the Examiner's position as consistent with the holding in *KSR*, which allows for the stated modification based on the number of entries and the unequal partitioning of the iterations which predictably result in less search cycles for fewer entries that are contained in the cache. Therefore, our decision included no new ground of rejection.

3. *Claim 22*

Appellants appear (Request 6) to take our statement with respect to the admitted prior art in the Decision as an acknowledgment that such teachings have not been shown to exist in the prior art. We stated that:

... although not intended as admission of prior art, Appellants' paragraph [0055] includes *recognition by Appellants* that, without any need for further detailed explanation, one of ordinary skill in the art would have been able to make the claimed implementation.

(Decision 8-9) (Emphasis added.) .

Such disclosure by Appellants is at least an acknowledgement that the modification for arranging the claimed elements on a single substrate would have been obvious to one of ordinary skill in the art. Again, consistent with

the Examiner's stated position (Ans. 5-6) that arranging the components of Michels on one substrate would have been obvious to one of ordinary skill in the art, we stated that such modification is further justified by the *KSR* holding as an obvious solution for a known problem (Decision 9). Thus, based on the state of the prior art as a whole, our decision with respect to claim 22 did not amount to a new ground of rejection. As such, considering the arguments made by Appellants and the legal precedence established by the *KSR* holding, we disagree with Appellants' assertion that more evidence should be added to the record in support of the Examiner's stated position.

In conclusion, based on the foregoing, we have granted Appellants' request to the extent that we have reconsidered our decision, but we deny Appellants' request to make any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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